REMARKS

Status of the Claims.

The Office Action dated 07/22/03 indicates that 67 claims are pending. Applicants note that the application as originally filed contained 66 claims and that no claims have been added. Accordingly, claims 1-9, 11, 16, 18-21, and 38-43 are pending with entry of this amendment, claims 10, 12-15, 17, 22-37, and 44-66 being cancelled and no claims being added herein. Claims 1, 2, 11, 16, and 38 are amended herein. These amendments introduce no new matter. Support is replete throughout the specification (*see, e.g.,* page 2, lines 9-10, the claims as originally filed, *etc.*).

Election/Restriction.

Pursuant to a restriction requirement made final, Applicants have canceled claims 10, 12-15, 17, 22-37, and 44-66 with entry of this amendment. Please note, however, that Applicants reserve the right to file subsequent applications claiming the canceled subject matter and the claim cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

Information Disclosure Statement.

Applicants note with appreciation the Examiner's thorough consideration of the references cited in the Information Disclosure Statement (Form 1449). Applicants further note that the Examiner states that "JP document 10099183 was not considered because the document was in Japanese and a translation of the document was not supplied" (see Office Action, page 9).

The PTO for 1449 contained a typographical error and the JP patent identified as 10099183 should have been listed as Japanese Patent 10099083.

Applicants further note that the document JP10099083 was supplied with a translation of the abstract. Moreover, **this document was considered by the Examiner and used to support a rejection under 35 U.S.C. §103(a) (*see* Office Action, page 11, line 4). Accordingly this reference should have been listed by the Examiner in the PTO Form 892 provided by the Examiner.** Applicants respectfully request the Examiner provide a Form 892 indicating that this reference has been cited.

35 U.S.C. §112, Second Paragraph.

Claims 1, 2-0, 11, 16, 18-21, and 38-43 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. In particular, the Examiner alleged that claim 1 is indefinite because the claimed method does not recite a positive step to relate the preamble of the invention to the recited steps. Claim 3 was allegedly indefinite because it recites the limitation "wherein said lower concentration is the absence of said test agent.

Claim 1, as amended herein recites

> 1. A method of screening for an agent that modulates the uptake of glutamate into a cell, said method comprising:
>
> i) contacting a cell comprising a VGLUT3 nucleic acid with a test agent; and
>
> ii) detecting expression or activity of said VGLUT3 **where an increase or decrease in the expression or activity of said VGLUT3 as compared to a control indicates that said test agent modulates the uptake of glutamate into a cell**. [emphasis added]

The preamble of the claim thus clearly recites "a method of screening for an agent that **modulates the uptake of glutamate into a cell**", while step (ii) recites "detecting expression or activity of said VGLUT3 where an increase or decrease in the expression or activity of said VGLUT3 . . . indicates that **said test agent modulates the uptake of glutamate into a cell.**" Step (ii) is clearly a positive step that relates the preamble of the invention to the recited steps. Accordingly, the rejection of claim 1 its dependent claims on these grounds should be withdrawn.

With respect to the rejection of claim three, applications note that it is well accepted that zero concentration of a substance is still a concentration of that substance. Nevertheless to expedite prosecution, claim 2 is amended herein to recite:

> 2. The method of claim 1, wherein said control is a negative control comprising contacting a cell at a lower concentration of said test agent, **or in the absence of said test agent.**

thereby obviating this rejection. In view of the foregoing, Applicants believe all rejection under 35 U.S.C. §112, second paragraph, should be withdrawn.

Allowable subject matter.

Applicants note with appreciation the Examiner's indication that VGLUT3 is free of the prior art of record. Accordingly to expedite prosecution Applicants have amended the claims to solely recite VGLUT3 thereby obviating the rejections under 35 U.S.C. §102(b) and §103(a) as explained below. Applicants note that these amendments are not to be construed as dedication to the public, abandonment, or agreement with the Examiner's position and Applicants reserve the right to file subsequent applications claiming the canceled or amended subject matter.

35 U.S.C. §102.

Claims 38-40, and 42 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Bellocchio *et al.* (1998) *J. Neurosci.,* 18: 8648-8659. According to the Examiner Bellocchio *et al.* allegedly teaches a COS1 cell transfected with BNPI transporter.

Claims 38-40, as amended herein, are directed to:

> 38. A cell comprising a heterologous nucleic acid encoding a glutamate transporter **wherein said glutamate transporter is VGLUT3**. **[emphasis added]**

Bellocchio *et al.* offers no mention or teaching whatsoever regarding VGLUT3. Thus, claims 38-40 are not anticipated and the rejection of these claims under 35 U.S.C. §102(b) should be withdrawn.

35 U.S.C. §103(a).

Claims 1, 2-9, 11, 16, 18-21, 38-40, and 42 were rejected under 35 U.S.C. §103(a) as allegedly obvious in light of Bellocchio *et al., supra.,* in view of Hediger *et al.* (U.S. 5,739,284) or Shashidharan *et al.* (WO 98/11222) or JP 10099083), and McIntire *et al.* (1997) *Nature* 389: 870-876, and Conradt *et al.* (1997) *J. Neurochem.*, 68: 1244-1251.

The claims, as amended herein, are directed to screening methods utilizing VGLUT3 and to cells expressing a heterologous nucleic acid encoding VGLUT3.

The cited art offers no teaching or suggestion whatsoever regarding VGLUT3. Indeed, as stated by the Examiner, "VGLUT3 is free of the prior art of record." Lacking any teaching or

suggestion whatsoever of VGLUT3, the combination of references fails to teach or suggest screening methods utilizing VGLUT3 nucleic acids or peptides or cells expressing VGLUT3.

Accordingly, the Examiner has failed to make his *prima facie* case of obviousness with respect to the presently pending claims and the rejection of these claims under 35 U.S.C. §103(a) should be withdrawn.

In view of the foregoing, Applicants believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Should the Examiner seek to maintain the rejections, Applicants request a telephone interview with the Examiner and the Examiner's supervisor.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 769-3513.

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Respectfully submitted,

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